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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,799	09/18/2003	Robert M. H. Dunn	CA920030059US1	9024
46/073 7590 09/23/2008 IBM CORPORATION (VE) C/O VOLEL EMILE P. O. BOX 162485 AUSTIN, TX 78716				
EXAMINER				
DAYE, CHELSEA L				
ART UNIT		PAPER NUMBER		
2161				
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09/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* ROBERT M. H. DUNN,  
VICTOR S. CHAN,  
BRENDA M. LAM,  
WAN NGAI W. LEE  
LEV MIRLAS,  
AND PAUL K. H. YU

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Application No. 10/666,799  
Technology Center 2161

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Mailed: September 23, 2008

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Before KRISTA ZELE *Deputy Chief Appeals Administrator*  
ZELE, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on February 15, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

### **APPEAL BRIEF, APPEALED CLAIMS**

Appellants have not appealed all rejected claims. Specifically, a review of the Grounds of Rejection on the record finds that rejections are outstanding for the following pending claims: 4, 25, 30, and 35. The rejected claims that have not been appealed and/or argued for appeal are claims 4, 35, 30, and 35.

### **DISCUSSION**

The Board of Appeals and Interferences (Board), in *Ex parte Ghuman*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/rm081175.pdf> (BPAI May 14, 2008) (precedential), held that in appeals where rejected claims are expressly withdrawn, or are implicitly withdrawn by not presenting arguments in support of patentability, the Board will remand (or return) the application to the Examiner with instructions to cancel the expressly or implicitly withdrawn claims. *See also Manual of Patent Examining Procedure* (MPEP) § 1215.03 (8<sup>th</sup> ed. Rev. 6, Sept 2007).

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to enter a paper canceling claims 4, 25, 30, and 35; and
- 2) upon entry of the paper, to return the application to the Board for the consideration of appealed claims;

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

KZ/dal

IBM CORPORATION (VE)  
C/O VOLEL EMILE  
P.O. BOX 162485  
AUSTIN, TX 78716